



**REMARKS**

Claims 1-23 are pending in the application. Claims 1, 5 and 14 are the independent claims.

**The Claims Are Not Anticipated by Shirley**

The Examiner has rejected previously pending claims 1-4 under 35 U.S.C. § 102(e) as being anticipated by Shirley (U.S. Patent No. 5,692,206). Applicant respectfully traverses this rejection, and submits that each pending claim is patentably distinguishable over Shirley.

In order for a claim to be anticipated under 35 U.S.C. § 102, the reference must disclose, either expressly or inherently, each and every element as set forth in the claim. M.P.E.P. § 2131. Such anticipation does not occur in the instant application, however, because Shirley fails to disclose each and every element as set forth in the pending claims.

Independent claim 1 recites, among other things, “produc[ing] said request for proposal,” “sending said request for proposal . . . as a first overlay to a design builder,” “preparing a responding proposal from said design builder by adding . . . to said first overlay” and “sending said second overlay from said design builder to said owner.” Independent claims 5 and 14 recite, among other things, “generating . . . a first overlay representing the request for proposal” and “receiving . . . a second overlay . . . representing the responding proposal to the request for proposal [and] comprising a modified version of the first overlay.”

Shirley neither teaches nor discloses the generation of both a request for proposal and the responding proposal, as recited in the present independent claims. The system in Shirley is only capable of generating one particular type of contract, such as “a ground lease, real estate purchase, a space lease, or a shopping center lease.” (Shirley, col. 7: lns 14-21, FIG. 6). No matter how many users collaborate or interact in the creation of the contract in Shirley, they are all working to produce only a single document with a single purpose - the contract. Thus, Shirley does not anticipate the pending independent claims, which require the generation of two different types of documents having different purposes - a request for proposal, and a proposal.

Accordingly, for at least these reasons, Shirley does not anticipate pending independent claims 1, 5 and 14. Furthermore, as each of the pending dependent claims depend from and further limit their respective independent claims, Applicant respectfully submits that for at least the same reasons as above all of the pending dependent claims are not anticipated by Shirley under 35 U.S.C. § 102.

### **CONCLUSION**

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the claims by this Response to Office action. The attached page is captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE.**"

The Office is authorized to charge the three-month small entity extension of time fee of \$465.00 to Deposit Account No. 11-0600. The Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600. A duplicate of this sheet is provided for this purpose.

The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

KENYON & KENYON

Dated: March 4, 2003

By: Bradley J. Meier  
Bradley J. Meier  
(Reg. No. 44,236)

KENYON & KENYON  
1500 K Street, N.W., Suite 700  
Washington, D.C. 20005  
(202) 220 - 4200 (telephone)  
(202) 220 - 4201 (facsimile)

Accordingly, for at least these reasons, Shirley does not anticipate pending independent claims 1, 5 and 14. Furthermore, as each of the pending dependent claims depend from and further limit their respective independent claims, Applicant respectfully submits that for at least the same reasons as above all of the pending dependent claims are not anticipated by Shirley under 35 U.S.C. § 102.

### CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the claims by this Response to Office action. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

The Office is authorized to charge the three-month small entity extension of time fee of \$465.00 to Deposit Account No. 11-0600. The Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600. A duplicate of this sheet is provided for this purpose.

The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

KENYON & KENYON

Dated: March 4, 2003

By: Bradley J. Meier  
Bradley J. Meier  
(Reg. No. 44,236)

KENYON & KENYON  
1500 K Street, N.W., Suite 700  
Washington, D.C. 20005  
(202) 220 - 4200 (telephone)  
(202) 220 - 4201 (facsimile)



**PATENT**  
Appl'n No.: 09/835,481  
Attny Dkt No.: 10633-13

**VERSIONS WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

Claims 5-23 have been added.